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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/580,363

01/29/2007

Christopher Glen Clemens

70342/UST

1724

26748

7590

05/07/2008

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EXAMINER

BROOKS, KRISTIE LATRICE

ART UNIT

PAPER NUMBER

1616

MAIL DATE

DELIVERY MODE

05/07/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/580,363	Applicant(s) CLEMENS ET AL.	
	Examiner Kristie L. Brooks	Art Unit 1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 3, 4 and 7-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2 and 13-19 is/are rejected.
- 7) ☒ Claim(s) 2 and 13-17 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/ are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>5/23/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

Applicant is requested to elect in claim 2, a HPPD-inhibiting herbicide selected from isoxazole, triketones, pyrazoles, benzobicyclon and ketospiradox:

Upon election of a HPPD-inhibiting herbicide selected from isoxazole, triketones, pyrazoles, benzobicyclon and ketospiradox Applicant is further required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

2. The claims are deemed to correspond to the species listed above in the following manner:

They are all different types of HPPD-inhibiting herbicides.

The following claim(s) are generic: 1.

3. The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons:

The technical feature linking the species is the combination of an HPPD-inhibiting herbicide and an insecticide. However, Cornes (US 6,924,250) teaches a combination of an HPPD-inhibiting herbicide and an insecticide that is in the instant claims.

Therefore, there is lack of unity a posteriori because the technical feature linking the species does not define a contribution over the prior art

Telephone Election

4. During a telephone conversation with William Teoli, a provisional election was made with traverse to prosecute the invention of triketones and a further election of mestrione, in claim 5. Affirmation of this election must be made by applicant in replying to this Office action. Claims 3-4 and 7-12 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected species.

Status of Application

5. Claims 1-19 are pending.
6. Claims 3-4 and 7-12 are withdrawn from further consideration by the examiner, as being drawn to a non-elected species and claims 1-2 and 13-19 are presented for examination.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a

terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1-18 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-20 of US Patent No. 6,746,988.

Although the conflicting claims are not identical, they are not patentably distinct from each other because they both encompass an agricultural composition comprising at least one agriculturally active compound. The instant invention differs from the cited patent by reciting the use of an HPPD-inhibiting herbicide and an insecticide. However, claim 15 of the cited patent recites the use of herbicides, insecticides, a safeners or a mixture thereof which allows for the combination agricultural active ingredients. And claims 16-18 of the cited patent, further recite the use of specific herbicides (i.e. mesotrione, an HPPD-inhibiting herbicide or acetochlor), insecticides and safeners. Therefore, both applications are directed to similar subject matter wherein the composition comprises at least one agriculturally active ingredient.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. Claims 1-2 and 13-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hopkinson et al. (US 6,746,988).

Applicant claims a pesticidally active combination comprising a HPPD-inhibiting herbicide and an insecticide.

Determination of the scope and content of the prior art
(MPEP 2141.01)

Hopkinson et al. teach agricultural compositions comprising agriculturally active compounds, alkyl polyglycosides, surfactant systems, and basic compounds (see the entire article, especially the abstract). The surfactant systems help produce agricultural concentrates that exhibit good chemical and physical stability as well as excellent tank-mix properties (see the entire article, especially column 2 lines 46-55). The agriculturally active compounds can be used singly or in combination with 2,3,4,5,6,7, or more

compounds. Examples of insecticides include acrinathrin, amitraz, DDT, methoxychlor and salts thereof, herbicides include mesotrione, acetochlor, dicamba, glyphosate, metolachlor and salts thereof, and safeners include benoxachlor (see the entire article, especially column 9 lines 11-13 and 16-34, column 8 lines 11-67). Some examples of combinations include mesotrione, S-metolachlor and benoxacor or mesotrione, S-metolachlor, benoxacor and atrazine (see the entire article, especially column 9 lines 18-34). The compositions can be provided as a pre-mix composition and may be applied pre-emergence and/or post emergence to desired area (i.e. plants, soil, roots, seeds, stems, etc.) (see the entire article, especially column 10 lines 62-67, column 11 lines 1-6, and Examples 1-4):

Ascertainment of the difference between the prior art and the claims
(MPEP 2141.02)

Hopkinson et al. do not teach an exemplified formulation of the instant components.

Finding of prima facie obviousness
Rational and Motivation (MPEP 2142-2143)

It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to make a formulation of the instant components.

One of ordinary skill in the art would have been motivated to do this because Hopkinson et al. combinations of the instant agrochemical actives in making improved chemical and physical compositions. Thus, it would have been obvious to one of ordinary skill in the art to make a composition with the instant components so as to achieve an enhanced stable composition for improved application to desired area and for better preparation of commercial products in the agricultural industry. Therefore, the claimed invention would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made because the prior art is fairly suggestive of the claimed invention.

Conclusion

11. No claims are allowed.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kristie L. Brooks whose telephone number is (571) 272-9072. The examiner can normally be reached on M-F 8:30am-6:00pm Est..


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann R. Richter can be reached on (571) 272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KB



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